

REMARKS

Claims 1, 3 through 6 and 8 through 20 are pending in this application. Claims 1, 3, and 4 have been amended, claims 2 and 7 cancelled, and new claims 11 through 20 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure, noting that new claims 19 and 20 stem from original claim 7. Applicant submits that the present Amendment does not generate any new matter issue.

The Drawings

The Examiner asserted that Fig. 5 should be designated by a legend such as “Prior Art”. In response, the attached Replacement Sheet includes Fig. 5 provided with the caption “Prior Art” as requested by the Examiner.

Claims 1 through 10 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner identified a basis in support of the rejection and courteously suggested remedial language. This rejection is traversed.

In response claim 1 has been amended as courteously suggested by the Examiner, thereby overcoming the stated basis for the imposed rejection. Clearly, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicant, therefore, submits that the imposed rejection of claims 1 through 10 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicits withdrawal thereof.

Claims 1, 8 and 9 were rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Shih.

This rejection is traversed. Specifically, advertent to the paragraph bridging pages 5 and 6 of the September 19, 2005 Office Action, the Examiner courteously acknowledged that if claim 1 is amended to overcome the indefinite rejection by inserting “and an electronic circuit” after “optical device” and by changing “and” to “the” in line 7, the rejection predicated upon Shih would be overcome. By the present Amendment claim 1 has been amended as suggested by the Examiner, thereby admittedly overcoming the imposed rejection under 35 U.S.C. § 102.

Based upon the foregoing Applicant submits that the imposed rejection of claims 1, 8 and 9 under 35 U.S.C. § 102 for lack of novelty as evidenced by Shih is not factually viable and, hence, solicits withdrawal thereof.

Claims 1, 2 and 7 through 10 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Yonemura et al.

This rejection is traversed. Specifically, and again advertent to the paragraph bridging pages 5 and 6 of the September 19, 2005 Office Action, the Examiner also courteously acknowledged that if claim 1 is amended to emphasize that the base touches the surface of the stem, the imposed rejection predicated upon Yonemura et al. would be overcome. In response, claim 1 has been amended as suggested by the Examiner by clarifying that the base is in direct contact with the stem, thereby admittedly overcoming the imposed rejection under 35 U.S.C. § 102 predicated upon Yonemura et al.

Applicant, therefore, submits that the imposed rejection of claims 1, 2 and 7 through 10 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yonemura et al. is not factually viable and, hence, solicits withdrawal thereof.

New claims 11 through 20

New claims 11 through 20 are free of the applied prior art by virtue of the limitations expressed therein. Applicants would note that the light-emitting module defined in claim 11 comprises lead terminals extending from the stem to connect the light-emitting device in electrical contact with the electronic circuit on the substrate and, specifies that the base is in direct contact with the stem. Applicants would further note that in accordance with the light-emitting module defined in claim 19, the base and the stem are intricately formed by sintering. Since the base is in direct contact with the stem, heat dissipation is highly effective. Accordingly, claims 11 through 20 are free of the applied prior art.

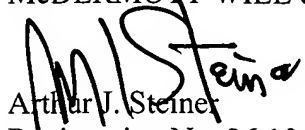
Applicants acknowledge, with appreciation, the Examiner's indication that claims 3 through 6 contain allowable subject matter. Based upon the foregoing it should be apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/717,909

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "A. J. Steiner", is written over the printed name.

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AMENDMENTS TO THE DRAWINGS

The attached REPLACEMENT SHEET includes a change to Fig. 5, as requested by the Examiner. Specifically, Fig. 5 has been amended by including the caption "PRIOR ART" as requested by the Examiner.